

## REMARKS

This application has been reviewed in light of the Office Action dated April 7, 2004. Claims 66-68, 70-74, 89, 90, 91-96 are presented for examination, of which Claims 66 and 89, 91, 92 and 96 are in independent form. Claims 66, 68 and 89 have been amended to define still more clearly what Applicant regards as his invention and Claims 91-96 have been added to provide Applicant with a more complete scope of protection. Favorable reconsideration is requested.

Claims 66-68, 70-72, 89 and 90 were rejected under 35 U.S.C. § 103(a) as being obvious from U.S. Patent No. 6,192,045 (Williams et al.) in view of U.S. Patent No. 6,421,429 (Merritt et al.); Claim 73, as being obvious from Williams et al. in view of Merritt et al., and further in view of U.S. Patent No. 6,211,972 (Okutomi et al.); and Claim 74, as being obvious from Williams et al. in view of Merritt et al., and further in view of U.S. Patent No. 5,872,845 (Feder), and further in view of WIPO Publication No. WO 97/10668 (Kulakowski).

Independent Claim 66 is directed to an image communication method that utilizes a plurality of Internet facsimile modes and a G3 facsimile mode. A detection is made as to which of those Internet facsimile modes a destination apparatus of image data has. This determination is made during communication in the G3 facsimile mode, in accordance with a first procedure signal of the G3 facsimile mode from the destination apparatus. An Internet facsimile mode is selected for communication with the destination apparatus from the plurality of Internet facsimile modes based on the detected Internet facsimile mode, and the destination apparatus is directed to switch to the selected Internet

facsimile mode. Then, an image is transmitted to the destination apparatus based on the directed Internet facsimile mode.

Among other notable features of Claim 66 are (1) detecting an Internet facsimile mode, that a destination apparatus has, in accordance with a G3 facsimile procedure signal from the destination apparatus, (2) selecting an Internet facsimile mode for communicating with the destination apparatus from the plurality of Internet facsimile modes based on the detected Internet facsimile mode, and (3) transmitting an image to the destination apparatus based on the directed Internet facsimile mode.

Williams et al., as understood by Applicant, relates to minimizing connect-time charges associated with dial-up data networks.

As discussed in Williams et al., when a user wants to send a fax over the Internet, the user adds a special code (such as \*\*2) to the phone number of the receiving fax machine. When sending fax machine 51, shown in Fig. 9, initiates sending the fax, the attached fax call-back device 53 detects the special code and intercepts the call, as shown in blocks 70 and 71 (Fig. 12). Fax call-back device 53 begins the call-back sequence by sending ringing signals to sending fax machine 51 so that it appears that the connection is proceeding normally, as indicated in block 73. Next, fax call-back device 53 establishes a connection 61 to local exchange carrier (LEC) by going off-hook, as shown in FIG. 10. It then transmits signaling tones received from sending fax machine 51 to LEC 55 corresponding to the phone number of receiving fax machine 52, as indicated in block 62. LEC 55 establishes a connection 63 via a long distance carrier 59 (LDC) to the LEC 56 located near the receiving fax machine 52.

LEC 56 signals fax callback device 54 attached to receiving fax machine 52 of the incoming phone call by generating a ringing signal. Waiting in block 82, fax call-back device 54 answers the incoming phone call 62 (block 83) and waits to see if incoming phone call 62 is immediately terminated as shown in block 84. Sending fax callback device 53, waiting in block 75, detects that fax callback device 54 has answered incoming phone call 62 and immediately terminates phone call 61, as shown in block 76, to avoid any PSTN-related charges. If fax call-back device 54 detects that an incoming phone call 62 from LEC 56 was not immediately terminated, fax call-back device 54 routes the incoming phone (fax) call 62 to receiving fax machine 52, as indicated in block 85, which receives and processes the fax normally, as indicated in block 43. If incoming phone call 62 from LEC 56 was immediately terminated, then, once call 62 has terminated, fax call-back device 54 establishes a connection 62 to local exchange carrier (LEC) 56 by going off-hook. It then transmits signaling tones to LEC 56 corresponding to a preprogrammed phone number associated with the immediately terminated call, and connects to the fax call-back device's Internet Service Provider (ISP) 58. LEC 56 establishes a connection 66 to Internet 60 via ISP 58. Fax call-back device 54 is now connected to Internet 10 and is ready to receive the fax as indicated in block 87 and Fig. 11.

The Examiner, at page 5 of the Office Action, cites Fig. 12, and column 8, line 44 to column 9, line 20 of Williams et al., as allegedly disclosing “detecting an Internet facsimile mode, which a destination apparatus of image data has, from the plurality of Internet facsimile modes during communication in the *facsimile mode*, in accordance with a first procedure signal of the *facsimile mode* from the destination apparatus.” (Emphasis in original.) Referring to Figure 12, the Examiner asserts, at page 3 of the Office Action,

that “upon receiving a procedure signal from the receiving device after step 83, seen as the dashed line, a transmission mode is determined or detected (being either the facsimile mode, which proceeds to step 85, or a digitized Internet mode, being steps 77-79), based on the entries in the tables of Figs. 2 and 3.” According to the Examiner, “because the originating apparatus detects that a destination apparatus answers the call, one of ordinary skill in the art can recognize that the use of an internet facsimile mode is determined or detected at this point.” (See page 3 of Office Action.)

Applicant respectfully submits that the Examiner has misunderstood the Williams et al. reference. Specifically, the dashed line after step 83 in Figure 12 merely represents the detection by the sending call back device 53 that the receiving call back device 54 has answered the incoming phone call, thereby prompting the sending call back device 53 to immediately terminate the phone call (column 8, line 63 - column 9, line 3). There is nothing in the cited portion of Williams et al., or indeed any other portion of that patent, that would even hint of detecting an Internet facsimile mode, which a destination apparatus of an image data has, based on a signal from a destination apparatus of the image data.

The Examiner’s assertion that a transmission mode is determined or detected based on the entries of the tables of Figures 2 and 3 is simply not supported by the disclosure of Williams et al. Even assuming the Data Network types identified in those tables are “Internet facsimile modes” (an assumption with which Applicant does not agree), nothing in Williams et al. teaches or suggests that the tables are used by the sending apparatus to detect the Internet facsimile mode of the destination apparatus. Rather, the table of Figure 2 is merely used by the sending computer to obtain the phone number of the

computer to which it needs to transfer data (column 5, lines 59-64; column 7, lines 10-14); and the table of Figure 3 is merely used by the receiving computer to determine if the phone number obtained from the Automatic calling Number Identification Information (ANI ) is contained in the table. If it is not, the receiving computer will process the phone call normally (column 6, lines 22-32; column 7, lines 38-46).

As Williams et al. fails to teach or suggest detecting an Internet facsimile mode, which a destination apparatus of an image data has, in accordance with a signal from a destination apparatus of the image data, Williams et al. also fails to teach or suggest detecting an Internet facsimile mode which the destination apparatus has, from among a plurality of Internet facsimile modes, in accordance with a G3 facsimile procedures signal from the destination apparatus of the data, as recited in Claim 66.

In addition, nothing has been found in Williams et al. that would teach or suggest “selecting an Internet facsimile mode for communicating with the destination apparatus from the plurality of Internet facsimile modes based on the detected Internet facsimile mode,” or “transmitting an image to the destination apparatus based on the directed Internet facsimile mode,” as recited in Claim 66.

The disclosure of Merritt et al. does not remedy the deficiencies of Williams et al. Merritt et al. relates to a system that enables images to be communicated between dissimilar devices. Apparently, a calling device 30 sends an image via a network to a network image processing system ("image nodal processor") 10, which converts the image to a format and a protocol suitable for a called device 40. The converted image file is then sent to the called device 40.

However, Merritt et al. fails to teach or suggest detecting an Internet facsimile mode, which a destination apparatus of image data has, in accordance with a signal from the destination apparatus of the image data. The Office Action cites column 5, lines 51-65, and column 11, line 16-36 of Merritt et al. Column 5, lines 51-65 of Merritt et al. is understood to discuss merely that there are several access modes for the image nodal processor depicted in Fig. 1A, and that, at the low end, access into the nodal server may be via a FAX/modem, in CCITT (ITU) Group 3 file format; however, nothing in that portion of Merritt et al. is deemed to teach or suggest detecting an Internet fax mode of a destination apparatus during communication in the G3 facsimile mode, in accordance with a first procedure signal of the G3 facsimile mode from the destination apparatus.

Further, the cited portion of Merritt et al. in column 11 is understood to relate to the use of a handshake procedure for the image nodal processor 10 to notify the calling device 30 of a format for sending an image to the called device 40, if the calling device 30 is to directly send the image to the called device. That is, Merritt et al. teaches that an intermediary device (the image nodal processor 10) is required to transmit format information between the calling device 30 and the called device 40. According to the method of Claim 66, an Internet facsimile mode is detected during communication in the G3 facsimile mode, and no intermediary device is required.

In addition, nothing has been found in Merritt et al. that would teach or suggest “selecting an Internet facsimile mode for communicating with the destination apparatus from the plurality of Internet facsimile modes based on the detected Internet facsimile mode,” or “transmitting an image to the destination apparatus based on the directed Internet facsimile mode,” as recited in Claim 66.

Accordingly, nothing in Williams et al. or Merritt et al., either separately or in any combination (assuming for argument's sake that such combination would be permissible), teaches or suggests (1) detecting an Internet facsimile mode, which a destination apparatus has, from a plurality of Internet facsimile modes in accordance with a G3 facsimile procedure signal from the destination apparatus, (2) selecting an Internet facsimile mode for communicating with the destination apparatus from the plurality of Internet facsimile modes based on the detected Internet facsimile mode, or (3) transmitting an image to the destination apparatus based on the directed Internet facsimile mode, as recited in Claim 66.

Accordingly, Claim 66 is believed to be clearly allowable over Williams et al. or Merritt et al., either separately or in any permissible combination (if any).

A review of the other art of record has failed to reveal anything which, in Applicant's opinion, would remedy the deficiencies of the art discussed above, as a reference against Claim 66.

Independent Claim 89 is directed to an image communication apparatus that utilizes a plurality of Internet facsimile modes and a G3 facsimile mode. The apparatus includes a detection unit adapted to detect an Internet facsimile mode which a destination apparatus of image data has from the plurality of Internet facsimile modes, during communication in the G3 facsimile mode, in accordance with a first procedure signal of the G3 facsimile mode from the destination apparatus, and a selection unit adapted to select an Internet facsimile mode for communicating with the destination apparatus based on the Internet facsimile mode detected by the detection unit. The apparatus also includes a direction unit adapted to direct the destination apparatus to switch to the Internet facsimile

mode selected by the selection unit; and a transmission unit adapted to transmit an image based on the Internet facsimile mode selected by the selection unit.

Claim 89 is believed to be clearly allowable over Williams et al. and Merritt et al. for at least the same reasons as discussed above in connection with Claim 66.

Newly added Claim 91 is directed to an image communication method that utilizes an Internet facsimile mode and a G3 facsimile mode. The method includes the steps of determining an Internet facsimile function of a destination apparatus based on a G3 facsimile procedure signal transmitted from the destination apparatus during communication in the G3 facsimile mode; directing the destination apparatus to switch to the Internet facsimile mode in accordance with a determination in said determining step; and transmitting an image to the destination apparatus by switching to the Internet facsimile mode in accordance with the response to the direction of said directing step.

Nothing has been found in Williams et al. or Merritt et al., either separately or in any combination (assuming for argument's sake that such combination would be permissible), that would teach or suggest (1) determining an Internet facsimile function of a destination apparatus based on a G3 facsimile procedure signal transmitted from the destination apparatus during communication in the G3 facsimile mode, (2) directing the destination apparatus to switch to the Internet facsimile mode in accordance with a determination in said determining step, or (3) transmitting an image to the destination apparatus by switching to the Internet facsimile mode in accordance with the response to the direction of said directing step, as recited in Claim 91.

Accordingly, Claim 91 is believed to be clearly allowable over Williams et al. or Merritt et al., either separately or in any permissible combination (if any).



A review of the other art of record has failed to reveal anything which, in Applicant's opinion, would remedy the deficiencies of the art discussed above, as a reference against Claim 91.

Newly added Claim 92 is directed to an image communication method that has an Internet facsimile mode and a G3 facsimile mode and is capable of detecting a facsimile function of a destination apparatus based on a G3 facsimile procedure transmitted from the destination apparatus and of communicating in said Internet facsimile mode based on the detection. The method includes the steps of (1) memorizing presence or absence of the Internet facsimile function of other communication apparatuses and receiving capacity of the Internet facsimile function of the other communication apparatus into a memory; and (2) communicating in said Internet facsimile mode in accordance with a specific condition, when it is determined that the destination apparatus designated by a user has the Internet facsimile function and said memory does not memorize the receiving capacity of the Internet facsimile function of the destination apparatus based on information memorized in said memory.

Nothing has been found in Williams et al. or Merritt et al., either separately or in any combination (assuming for argument's sake that such combination would be permissible), that would teach or suggest "communicating in said Internet facsimile mode in accordance with a specific condition, when it is determined that the destination apparatus designated by a user has the Internet facsimile function and said memory does not memorize the receiving capacity of the Internet facsimile function of the destination apparatus based on information memorized in said memory," as recited in Claim 92.

Accordingly, Claim 92 is believed to be clearly allowable over Williams et al. or Merritt et al., either separately or in any permissible combination (if any).

A review of the other art of record has failed to reveal anything which, in Applicant's opinion, would remedy the deficiencies of the art discussed above, as a reference against Claim 92.

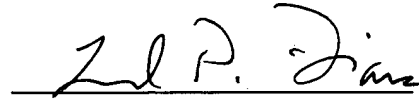
Independent Claim 96 is an apparatus claim corresponding to method Claim 92 and is believed to be patentable over the cited prior art for at least the same reasons as discussed above in connection with Claim 92.

The other rejected claims in this application depend from the independent claims discussed above and, therefore, are submitted to be patentable for at least the same reasons. Since each dependent claim is also deemed to define an additional aspect of the invention, individual consideration or reconsideration, as the case may be, of the patentability of each claim on its own merits is respectfully requested.

In view of the foregoing amendments and remarks, Applicant respectfully requests favorable reconsideration and early passage to issue of the present application.

Applicant's undersigned attorney may be reached in our New York Office by telephone at (212) 218-2100. All correspondence should continue to be directed to our address listed below.

Respectfully submitted,

A handwritten signature in cursive script, appearing to read "L. P. Diana", is written over a horizontal line.

Leonard P. Diana  
Attorney for Applicant  
Registration No. 29,296

FITZPATRICK, CELLA, HARPER & SCINTO  
30 Rockefeller Plaza  
New York, New York 10112-3801  
Facsimile: (212) 218-2200

NY\_MAIN 509966v2